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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,739	11/30/2001	Claude A. Marbler	ATM-2301	4484

7590 07/18/2006

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Washington, DC 20006

EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/996,739

Applicant(s)

MARBLER ET AL.

Examiner

Jane Rhee

Art Unit

1745

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 6/23/2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 12, 13, 17, 20, 22, 24, 27, 49 and 50.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: In response to applicant's argument that the 35 U.S.C. 112 first paragraph was applied incorrectly in the latest office action because applicant feels as though first paragraph section 112 only requires that the written description enables one skilled in the art to make and use the invention and not related to the statement where the specification does not reasonably convey to one skilled in that the applicant possessed the invention at the time applicant's invention was filed, according to MPEP 7.31.01 for the written description requirement, an applicant's specification must reasonably convey to those skilled in the art that the applicant was in possession of the claimed invention as of the date of invention.

In response to applicant's amendment of "at least two lines", applicant did not change the amendment from the prior amendment in the previous set of claims. The amendment of "at least two lines" is still rejected under section 112 first paragraph for the same reasons stated earlier in the prosecution therefore the rejection will not be withdrawn.

In response to applicant's argument the examiner's notes have been inconsistent because the examiner can not correctly take a position in one rejection and then an opposite position in the same matter in another rejection, first of all, applicant is claiming a negative limitation and according to the MPEP, any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support. Ex parte Parks, 30 USPQ2d 1234,1236 (Bd. Pat. App. & Inter. 1993). Secondly, figure 1 does not support the limitation "there being no other layer in contact with the plastic film during the cutting of the at least one line of perforations" because figure 1 is not directed to process but an article. Thirdly, specification page 2 lines 29-30 does not support the above limitation because it clearly states that "the layer of adhesive 16 may if desired already be present on the inner layer 14 before the cutting is performed." Fourthly, the burden is not on the examiner to prove that the process claim has new matter and to factually establish that the subject process phrase is not disclosed in the specification, new matter issue is based on the fact that the specification has no support for the new matter issue, therefore, obviously since a new matter rejection was made, the examiner did not find support for the new matter in the specification. Thus, the need to "prove" or "factually establish" the subject process phrase makes no sense because it's either supported by the specification or not supported by the specification. Finally, as to the inconsistency of the examiner's notes that the applicant disagrees with, applicant's claims are broadly examined by the examiner, hence the broad interpretation of the reference used to rejection the claims however, the specification disclosed by the applicant should clearly disclose applicant's invention and not need to be interpreted by the examiner in order to figure out applicant's invention, thus the reason for the inconsistency.

In response to applicant's argument that Niwa fail to disclose a notch that is situated between the two lines of the perforations, Olivieri et al. teaches that the notch is situated between the two lines of perforations (figure 8a number 431) for the purpose of tearing the materials forming the pack (col. 8 lines 57-58). Therefore; it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Niwa with the notch that is situated between the two lines of perforations in order to tear the materials forming the pack (col. 8 lines 57-58) as taught by Olivieri et al.

In response to applicant's argument that Olivier et al. teaches away from applicant's claimed invention because Olivier et al. only discloses forming perforations in a lower plastic layer of an already formed multilayer film after the multilayer film has been formed, Olivier et al. does not teach away from applicant's invention because Niwa teaches the process of preparing a multilayer packaging film and Olivier teaches a notch situated between the two lines of perforations. The Olivier reference was not used to teach the process limitation of applicant's multilayer packaging film but to teach a notch situated between the two lines of perforations.

In response to applicant's argument that Schlaeppi et al. teaches away from the use of a notch because of problems associated with the use of notches, Schlaeppi et al. was used to teach that it is well known in the art to secure the other layer to the inner layer by an adhesive or by other lamination or extrusion coating techniques (col. 4 lines 19-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Niwa with the precut plastic layer that is joined to the at least one other layer by means of extrusion to make up the multi-layered film as it is notoriously well known in the art to secure the other layer to the inner layer by an adhesive or by other lamination or extrusion coating techniques (col. 4 lines 19-21) as taught by Schlaeppi.